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OFFICE OF PETITIONS

In re Application of	:	
Burn et al.	:	
Application No. 10/733,407	:	DECISION ON PETITION
Filed: December 12, 2003	:	UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. 021565-122	:	

This is a decision on the petition under 37 CFR § 1.78(a)(6), filed September 21, 2007 and supplemented on November 16, 2007 to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for benefit of priority to the prior-filed provisional applications set forth in the concurrently filed amendment.

The petition is **DISMISSED AS MOOT**.

The petition is accompanied by a supplemental application data sheet to include a reference to the prior-filed provisional applications. While a reference to the prior-filed provisional applications was not included in an Application Data Sheet (ADS) or in the first sentence of the specification following the title as required by the rules, a reference, nevertheless, was made in the transmittal letter filed with the application.

Where a claim for priority under 37 CFR § 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR § 1.78(a)(5)(ii). On the other hand, if the USPTO does not note the claim for priority to the prior-filed applications set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR § 1.78(a)(6).¹ In the present case, the Office noted the claim for priority to the prior-filed provisional applications in the transmittal letter filed with the application, as shown by their inclusion on the filing receipt.

¹ Note MPEP 201.11 (III)(D) and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

In view of the above, the \$1,370 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

Although petitioner is not required to file a petition under 37 CFR 1.78(a)(6) in order to add the priority claim, petitioner must file a proper amendment or supplemental ADS in order to add the claim. The supplemental ADS filed November 16, 2007 is improper in so far as it fails to comply with the requirements of 37 CFR 1.312.

37 CFR 1.312 states,

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue.

MPEP 714.16 states,

[T]he amendment may be made as a matter of right in an application after the mailing of the application. Accordingly, the following are examples of "amendments" by applicant after allowance which must comply with 37 CFR 1.312:

- (A) an amendment to the specification,
- (B) a change in the drawings,
- (C) an amendment to the claims
- (D) a change in the inventorship,
- (E) the submission of prior art,
- (F) a petition to correct the spelling of an inventor's name,
- (G) a petition to change the order of the names of the inventors, etc.

Since the supplemental ADS seeks to change the file record the supplemental ADS is an "amendment" within the meaning of 37 CFR 1.312. Therefore, a supplemental ADS filed after the mailing of a Notice of Allowance must comply with 37 CFR 1.312.

MPEP 714.06 states, "an amendment under 37 CFR 1.312 must be filed on or before the date the issue fee is paid, except where the amendment is required by the Office of Patent Publication, see MPEP §714.16(d), subsection III." The supplemental ADS, was filed after payment of the issue fee and was not required by the Office of Patent Publication. Therefore, the supplemental ADS fails to comply with 37 CFR 1.312.

If petitioner wishes to add the priority claim, a petition to withdraw from issue and a Request for Continued Examination should be filed prior to issuance of the patent. Absent such action, the patent will issue without the claim. Petitioner should note a Certificate of Correction cannot be employed to correct an applicant's mistake by adding or correcting a priority claim under 35 U.S.C. 119(e) for an application on or after November 29, 2000.

The Office of Patent Application Processing will be informed of the instant decision and will issue the application as a patent , without the priority claim in the supplemental ADS, in due course unless a petition to withdraw the application from issuance is timely filed and granted.

Any questions concerning this decision on petition may be directed to Charlema Grant at (571) 272-3215.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is positioned above the printed name.

Anthony Knight
Supervisor
Office of Petitions